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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,404	01/26/2001	Theo Wallimann	8932-296	4809
20582	7590	06/07/2004	EXAMINER	
JONES DAY			WANG, SHENGJUN	
51 Louisiana Aveue, N.W				
WASHINGTON, DC 20001-2113			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/769,404

### Applicant(s)

WALLIMANN ET AL.

### Examiner

Shengjun Wang

### Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7, 13, 14, 20-24, 28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 13, 14, 20-24, 28 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Receipt of applicants' amendments and remarks submitted March 23, 2004 is acknowledged.

#### *Claim Rejections 35 U.S.C. 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 7, 13, 14, 20-24, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaddurah-Daouk (US 5,998,457) in view of Meisner (US 4,772,591), Grant et al. (US 5,888,553), Beale (US 5,756,469) and Beale (US 5,716,926).

3. Kaddurah-Daouk teaches a method of treating osteoporosis or osteoarthritis comprising administering therapeutical effective amount of creatine compound, or a pharmaceutical acceptable salt, to patient. See, particularly, the abstract, table 1-2, and claims 1-12.

4. Kaddurah-Daouk does not teach expressly the employment of creatine pyruvate for the treatment, or the particular amount administered, or the method may be employed for promoting growth and mineralization of bone; improving acceptance and osseous integration of bone; or accelerating healing as claimed in claims 22-24.

5. However, Grant et al. teaches that the excess of cortisol is known to be a cause of osteoporosis, tissue degeneration, and an anabolic composition with anticortisol effect are used to balance effect of cortisol. The anabolic composition comprising creatine. See, column 1, line 52 bridging column 2, line 59, column 5, lines 56-65. and claim 8. Meisner teaches a method for

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accelerated wound healing or treating degenerative disorders including periodontal disease osteoarthritis, comprising administering a composition comprising creatine to an animal or human. See, particularly, column 1, line 28 bridging column 2, line 45, column 5, lines 3 bridging column 7, line 10. Beale ('469) teaches creatine pyruvate (pyruvyl-creatine) is particularly useful as cortisol antagonist or cortisol blocker for prevent the catabolic activity of cortisol. See column 1, lines 7-18, 54-60; column 3, lines 46-63, and column 5, lines 54-60. Beale ('926) further teaches that pyruvate is known to be useful for treating osteoporosis. See, claim 24.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ creatine pyruvate for treating connective tissue degenerative disorders, including those unrelated to weight gain or weight lose, such as osteoporosis, osteoarthritis or periodontitis, or for accelerating wound healing, promoting growth of connective tissue (cartilage). Note claims 23 and 24 read on the composition comprising creatine pyruvate, since creatine pyruvate is both a creatine salt, and a pyruvate. A person of ordinary skill in the art would have been motivated to employ creatine pyruvate for treating connective tissue degenerative disorders, including those unrelated to weight gain or weight lose, such as osteoporosis, osteoarthritis or periodontitis, or for accelerating wound healing, promoting growth of connective tissue (cartilage) because it is prima facie obvious to combine two compounds each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus , the claimed invention which employ a combination (salt) of two compounds known to be useful for treating

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osteoporosis sets forth prima facie obvious subject matter. See In re Kerkhoven, 205 USPQ 1069. Note treating osteoporosis is to promoting mineralization of bone. Further, creatine pyruvate is particularly known to be useful for treating disease associated with cortisol activity and connective tissue degenerative disorders is known to be closely related to cortisol activity. Claims 22-24 are obvious because creatine is known to be useful for promoting tissue repair process, and treating osteoarthritis and osteoporosis would also be considered as a process of promoting tissue (cartilage) repairing since one of the major symptoms of osteoarthritis and osteoporosis is tissue degeneration. As to claims 28 and 30, note, in view of the teachings of Beale, Meisner and Grant, one of ordinary skill in the art would have appreciated that therapeutic effect of creatine pyruvate is not limited only to the symptoms related to weight gain or weight loss. Claims 13 and 14 are interpreted broadly as read on the elected invention, i.e., no foreign tissue has been introduced into the bone, since human bone is known to contain cells in general and chondroblasts cell particular. Finally, The optimization of a result effective parameter, e.g., the effective amount of creatine, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Furthermore, the instant claims are essentially directed to a particular salt of creatine for treating disorders known to be treated by creatine, or its derivatives, or its salts. Absent evidence to the contrary, the employment of pyruvate creatine is seen to be a selection from amongst equally suitable material and as such obvious. Ex parte Winters 11 USPQ 2<sup>nd</sup> 1387 (at 1388).

### ***Response to the Arguments***

Applicants' amendments and remarks submitted March 23, 2004 have been fully considered, but are not persuasive.

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6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Particularly, considering the cited references as a whole, it is known that: creatine compounds are useful for treating osteoporosis or osteoarthritis; excess of cortisol is a cause of osteoporosis, tissue degeneration, and anabolic composition with anticortisol effect are useful for balancing the effect of cortisol; creatine pyruvate is useful for accelerating wound healing or for treating degenerative disorders, including osteoarthritis; and creatine pyruvate (the elected compound, a salt of creatine) is a cortisol antagonist. Possessing all the knowledge mentioned above, one of ordinary skill in the art, would have seen the claimed invention, which is drawn to the employment of creatine pyruvate for treating bone or cartilage condition, or for promoting healing of bone disorders, prima facie obvious. The lack of express teaching by Grant that creatine is cortisol antagonist would not overcome the overall rejections since Beale disclosed that creatine pyruvate, the elected creatine compound, is a cortisol antagonist.

7. Further, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., without chromium) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

**SHENGJUN WANG**  
**PRIMARY EXAMINER**



Shengjun Wang

June 2, 2004